

# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

| APPLICATION NO.                           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/934,578                                | 08/23/2001  | Tetsuo Watanabe      | Q65941              | 7895             |
| 7590 02/24/2004                           |             |                      |                     |                  |
| SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC |             | EXAMINER             |                     |                  |
| 2100 Pennsylvania Avenue, N.W.            |             | CHANG, VICTOR S      |                     |                  |
| Washington, DC 20037                      |             |                      |                     |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 1771                 |                     |                  |
| DATE MAILED: 02/24/2004                   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.



### **DETAILED ACTION**

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 11/3/2003. Applicants' amendment to claim 1 and cancellation of claim 4 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, the Examiner for now withdraws the rejections of sections 3-5 of Paper No. 9, on the basis that newly amended claim 1 now recites at last line "with the proviso that the supporting base material does not contain a filler". This withdrawal is made assuming that Applicants have provided sufficient support for such amendment, so as to overcome the new grounds of rejection based upon the first paragraph of 35 U.S.C. 112, as follows.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

Art Unit: 1771

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner would like to respectfully repeat his earlier position (see Advisory, Paper No. 111403) and remind Applicants that the phrase "does not contain a filler" is inherently equivalent to "free of filler", which may be new matter under the rule of *Ex Parte Grasselli et al.* – Bd. of App. 231 PQ 393, Affd. 738 F. 2d 453 (Fed. Cir. 1984) to the effect that limitations such as "free of" a particular element are new matter in the absence of express support. However, in the newly filed RCE, Applicants failed to make response to rebut the Examiner's position as they were specifically requested to do in the Advisory action.

In particular, the Examiner repeats (see Advisory, Paper No. 111403) that while support for the aforementioned amendment may be found in the Specification, page 15, lines 15-16, the original recitation "Various kinds of additives and fillers can be added optionally to the mixture" appears to be somewhat vague and indefinite in that it is not clear that the original mixture was "free of" a filler, and also that what constitutes a "filler" and an "additive" appear to be somewhat vaguely defined. As stated above, clarification is requested.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

Art Unit: 1771

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-

1700

*Daniel Zinker*